

REMARKS

Counsel for the applicant wishes to thank the examiner for the courtesy of the telephone interview on March 5, 2009. The contents of the interview are incorporated in the following.

Claims 1-13, 15, 16, 18-25, 27-33, 35-41, and 43-45 are pending. Claims 14, 17, 26, 34, and 42 are canceled. Claims 1, 22, 30 and 38 are amended. Support for the amendments is located on, e.g., page 53, lines 17-21, page 54, lines 1-4; page 56, lines 13-15; page 58, lines 1-5; page 60, lines 15-17; and FIG. 24. Applicant respectfully requests favorable reconsideration and allowance of this application in view of the above amendments and the following remarks.

Claims 1-13, 15, 16, 18-25, 27-29, 38-41 and 43-45 were rejected under 35 USC 101 as being directed to non-statutory subject matter. At the interview, the examiner agreed that the amendment to claim 1 overcomes the rejection. Independent claims 1, 22, and 38 are amended similar and are therefore believed to be patentable. Withdrawal of the rejection is respectfully requested.

Claims 1-13, 15, 16, 18-25, 27-33, 35-41 and 43-45 were rejected under 35 USC 103(a) as being unpatentable over U.S. Patent Pub. No. 2002/0011636 to Grainger ("Grainger") in view of U.S. Patent No. 5,970,490 to Morgenstern ("Morgenstern"). Insofar as the rejection may be applied to the claims as amended, applicant respectfully traverses the rejection for reasons including the following, which are provided by way of example.

Independent claims 1, 22, 30, 38

The office action claims that Grainger discloses the elements recited in independent claims 1, 22, 30 and 38, except for "the attribute types are ordered in a tree-structure hierarchy." The office action overlooks and/or misquotes various amended claim language, and hence will be addressed as best understood.

Independent claim 1 recites, for example:

- “responsive to the selection of one of the attributes” automatically tagging the documents in the group with “the selected attributes, and with all attributes of all ancestors but not descendants or siblings according to the hierarchy of the selected attributes”, in combination with the limitation
- “accepting ... a user’s selection of a plurality of attributes to be associated with a single pre-determined attribute type ..., the selected attributes being predetermined and having different parent attributes ...”
- “storing ... respective references in association with the selected attributes and the ancestor attributes, for later retrieval of individual documents in the group by searching the ancestor attributes.”

(See also independent claims 22, 30, 38.) Consequently, an intellectual property document can be associated with plural attributes for each attribute type. For example, a patent for a chemical dye can have an attribute type of “product,” which is associated with plural different attributes, e.g., clothing, food, and hair care. The different attributes themselves have parents which are different, for example, Division which could be “Fashion Division” (for clothing and hair care) and “Neutraceuticals Division” (for food). The patent for the chemical dye will be returned in response to search queries not only for the product “clothing” but also food or hair care. (See page 53, last paragraph.)

Grainger and/or Morgenstern fail to teach or suggest at least the above limitations. According to the Grainger/Morgenstern combination, the user cannot enter plural attributes. Morgenstern discloses aggregation nodes (e.g., col. 21, lines 1-5), however, components in such aggregation nodes all have the same parent. Hence, the patent for chemical dye can only be

indicated as being related to, e.g., clothing and would not be returned in response to search queries for food or hair care.

The office action's argument is still not understood. The office action is understood to argue on one hand that Grainger's Case Data Unit corresponds to the recited group; Grainger's electronic documents in the Case Data Unit correspond to the recited documents in the group; and Grainger's case title, serial number, filing date, patent number, patent date, publication numbers, publication dates, client reference number, law firm reference number, country, inventors, status, assignee, assignment information, responsible practitioner, working practitioner, priority information (paragraphs [0016], [0057]) correspond to the recited attributes. On the other hand, the office action is understood to contend that Grainger's html links to "Save," "Cancel" and "Next" (Figure 3B) also amount to attributes or cause attributes to be automatically tagged. As best understood, it appears that the examiner contends that skipping a field in some of Grainger's attributes presented on a web page of a document in a Case Data Unit, and then selecting the "Next" function amounts to the recited "automatically tagging, in the first data storage, the documents in the group including the at least one document, with each selected attribute and with all attributes of all ancestors but not descendants or siblings in the hierarchy of each selected attribute" (e.g., claim 1).

Grainger

As agreed to in the interview, "storing ... respective references ... for later retrieval of individual documents in the group by searching the *ancestor* attributes" is very different from a typical search.

Furthermore, in comparison to Grainger, selecting Grainger's "Next" function does not cause the other documents to be associated with the "Save" or "Cancel" buttons (if the examiner

is interpreting those to be the attributes). Alternatively, selecting Grainger's "Next" function is not selecting one of the "attributes", in response to which the other documents are tagged.

As a further point of distinction, assuming that the examiner is contending that Grainger's attributes are the case title, serial number, etc., selecting a serial number (for example) does not cause the other documents in the group to include the case title and all of the case title's ancestors but not descendants or siblings. To the contrary, it appears that Grainger's attributes for the case data unit are simply applied to all of the documents when defined; hence, selecting one attribute causes only the one attribute to be applied to all of the documents. That is, in Grainger, selecting an attribute and skipping some fields (as possibly contended in the final office action) does not cause the unselected existing attributes (if modified as proposed in the office action to be in Morgenstern's tree structure) to be applied to the documents.

Accordingly, the combination of elements in the independent claims is respectfully submitted to be patentable over Grainger, alone or in combination with the other references.

Morgenstern

The Office action cites Morgenstern as teaching hierarchical tree structures to remedy Grainger's flat structure of a Case Data Unit containing a Document Entity, where it is not possible for an attribute to have both parent and child attributes. Nevertheless, even if Morgenstern and Grainger are combined, the combined teachings still fail to teach or suggest the claimed invention.

The Office action argues, for example, that three different kinds of aggregations listed in Morgenstern, col. 9, lines 60-68, teach or suggest selecting a plurality of attributes, and for each of the selected attributes, automatically tagging the documents as recited. However, Morgenstern's aggregating attribute fields for a record, aggregating an objects attributes and

methods, or aggregating set-valued attributes fails to teach or suggest selecting “a plurality of attributes to be associated with a single pre-determined attribute type” and automatically tagging the documents with the attributes of the ancestors of the selected attributes.

The rejection also cites Morgenstern col. 43, lines 7-20, as teaching attributes ordered in a tree-structure hierarchy. However, use of Morgenstern’s single attribute path fails to teach or suggest selecting a plurality of attributes and for each of the selected attributes, automatically tagging the documents as recited.

The Office action also cites the logical structure diagram with hyperedges of Morgenstern col. 12, lines 56-64, as teaching attributes ordered in a tree-structure hierarchy. However, a logical structure diagram, even annotated and including hyperedges, fails to teach or suggest selecting a plurality of attributes and for each of the selected attributes, automatically tagging the documents as recited.

Hence, Grainger and Morgenstern, alone or in combination, fail to teach or suggest the combination of features recited in independent claims 1, 22, 30 and 38. In addition, Grainger and Morgenstern clearly fail to show other recited elements as well.

With respect to the rejected dependent claims, applicant respectfully submits that these claims are allowable not only by virtue of their dependency from independent claims 1, 22, 30 and 38, but also because of additional features they recite in combination.

Furthermore, it is noted that the Office action fails to attempt to make a complete *prima facie* of obviousness for various dependent claims. These are outlined below. Each of these arguments was previously presented but has not been considered in the latest Office action.

Dependent Claims 4, 5

It is noted that the office action has typographical errors in its numbering of dependent claims 4 and 5, as noted for the fourth time. The office action switched the contents of claims 4 and 5. The examiner is respectfully requested to correct this error.

Dependent Claims 15, 25, 33, 41

Claim 15 recites that “the attributes are selected from a plurality of attribute types representative of at least one of: a product and a service.” The Office action argues that Grainger discloses a plurality of attribute types, and cites Grainger paragraphs [0134] and [0016]. The Office action is devoid of any indication where Grainger teaches attribute types representative of product or service. In any event, Grainger fails to teach or suggest attribute types representative of product or service. Accordingly, claim 15 is allowable over the reference.

Claims 25, 33, and 41 also include the same recitation as claim 15. The rejections of claims 25, 33 and 41 in the Office action merely refer back to the rejection of claim 15. Accordingly, claims 25, 33 and 41 are allowable over the references.

Dependent claim 18

Claim 18 additionally recites “the step of exporting the tree structure hierarchy including the attributes and the attribute types.” The Office action argues that Grainger paragraph [0016] discloses a plurality of attribute types, and that Grainger paragraph [0134] teaches attribute types associated with document entities. These citations are completely irrelevant and unrelated to the entirety of claim 18. The Office action is devoid of any attempt to argue that Grainger teaches exporting any data structure, let alone a tree structure hierarchy. In any event, Grainger does not teach or suggest exporting the tree structure hierarchy including attributes and attribute types. Therefore, claim 18 is allowable over the references.

Dependent claims 20, 28, 36, 44

Claim 20 depends from dependent claim 19. Claim 19 recites “further comprising utilizing the attributes as criteria for at least one of searching, retrieving, reporting and viewing the at least one document.” Claim 20 then recites that “the attributes can be utilized in combination with: (i) at least one of the attribute types, (ii) at least one sub-type of the at least one attribute type, (iii) a content of at least one field in the at least one document; (iv) a type of at least one field in the at least one document; and (vi) information derived from the at least one field in the at least one document.” The rejection appears to have mistaken the word “and” in claim 20 for the word “or”, and has considered only element (i) recited in claim 20: the Office action merely states with regard to claim 20 that “Grainger discloses ‘an attribute type’ (type attribute associated with document Entities, [0134]).” Where does Grainger teach elements (ii) to (vi)??

Because the Office action fails to even attempt to show where Grainger teaches five of the elements recited in claim 20, applicant respectfully submits that the rejection of claim 20 must be withdrawn.

Claims 28, 36 and 44 include the same recitations as claim 20. The rejections of claims 28, 36 and 44 in the Office action merely refer back to the rejection of claim 20. Accordingly, claims 28, 36 and 44 are allowable over the references.

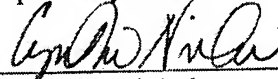
Applicant respectfully submits that, as described above, the cited prior art does not show or suggest the combination of features recited in the claims. Applicant does not concede that the cited prior art shows any of the elements recited in the claims. However, applicant has provided specific examples of elements in the claims that are clearly not present in the cited prior art.

Applicant strongly emphasizes that one reviewing the prosecution history should not interpret any of the examples applicant has described herein in connection with distinguishing over the prior art as limiting to those specific features in isolation. Rather, for the sake of simplicity, applicant has provided examples of why the claims described above are distinguishable over the cited prior art.

In view of the foregoing, applicant submits that this application is in condition for allowance. A timely notice to that effect is respectfully requested. If questions relating to patentability remain, the examiner is invited to contact the undersigned by telephone.

If there are any problems with the payment of fees, please charge any underpayments and credit any overpayments to Deposit Account No. 50-1147.

Respectfully submitted,


Cynthia K. Nicholson
Reg. No. 36,880

Posz Law Group, PLC
12040 South Lakes Drive, Suite 101
Reston, VA 20191
Phone 703-707-9110
Fax 703-707-9112
Customer No. 23400